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SUGHRUE MION, PLLC				
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SUITE 800				
WASHINGTON, DC 20037				
EXAMINER				
DANIEL JR, WILLIE J				
ART UNIT		PAPER NUMBER		
2617				
NOTIFICATION DATE		DELIVERY MODE		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/781,628

**Applicant(s)**

MURAI ET AL.

**Examiner**

WILLIE J. DANIEL JR

**Art Unit**

2617

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 January 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 7 and 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This action is in response to applicant's amendment filed on 24 January 2011. **Claims 1-3, 7, and 9** are now pending in the present application and **claims 4-6, 8, and 10-15** are cancelled. This office action is made **Final**.

### Specification

2. The disclosure is objected to because of the following informalities:
  - a. The amendment (filed 24 January 2011) of specification recites the language "...received **videvideo** information..." on pg. 2, [0039, line(s) 3-4]. The Examiner interprets as --received **video** information-- and suggests replacing said language to help clarify the specification.Appropriate correction is required.

### Double Patent Claiming

3. Applicant is advised that should claims 2 and 3 be found allowable, claim 2 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).
4. Applicant is advised that should claims 7 and 9 be found allowable, claim 7 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same

thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### **Claim Rejections - 35 USC § 103**

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-3, 7, and 9** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Barnes et al.** (hereinafter Barnes) (**US 2005/0136949 A1**) in view of **Shiotsu et al.** (hereinafter Shiotsu) (**US 7,142,204 B2**).

Regarding **claims 1, 7, and 9**, Barnes discloses a system (e.g., multi-network computer system MNCS) for distributing video information based on push technology { (see pg 4, [0041, lines 8-14]; pg. 6, [0061]; pg. 7, [0069, lines 1-7]; Figs. 1-3), where a MNCS is operated by a service provider }, comprising:

a mobile phone (e.g., device 101) that receives said video information (e.g., MPEG-4, movie, and/or video) from a video contents server (e.g., service provider) configured to store therein the video information to be distributed { (see pg. 4, 0040, lines 1-6); pg. 6, [0061]; pg. 11, [0111, lines 13-16];pg. 45, [0434]) };

a user management server which controls user registration and video information distribution via a network, wherein said video contents server is under control of said user

management server { (see pg. 20, [0206]; pg. 21, [0211]; pg. 24, [0239, lines 14-20]; pg. 45, [0434]) },

wherein a user request for a video information distribution service about an area to the user is received by said user management server in advance { (see pg. 38, [0368, lines 1-9]; pg. 37, [0361, lines 1-5]; pgs. 38-39, [0370]; pg. 45, [0434]), where the system provides information (see pg. 42, [0400, lines 1-3; 0401, lines 1-3]) }; and

a traffic monitoring apparatus that measures a traffic level of a radio channel to which the mobile phone is connected, wherein when said traffic is lower than a threshold { (see pg. 6, [0060, lines 1-9; 0066, lines 3-8, 18-21; 0067]), where the system determines a link condition for communication (see pg. 7, [0068]) as evidenced by the fact that one of ordinary skill in the art would clearly recognize },

said video information about the area is distributed from the video contents server to said mobile phone via said push technology { (see pg. 4, [0040, lines 1-6]; pg. 6, [0061]; pg. 11, [0111, lines 13-16]; pg. 45, [0434]) }, and

if the mobile phone is not in use and the video information has not already been provided { (see pg. 26, [0254, lines 7-8]; pg. 37, [0361, lines 1-5]) },

the video information is displayed in real time, wherein said video information about the area is distributed from the video contents server to said mobile phone via said push technology { (see pg. 38, [0368, lines 1-9]; pg. 45, [0434-0435]; pg. 6, [0061]) },

wherein when said traffic is lower than the threshold and when the mobile phone is in the area { (see pg. 6, [0060, lines 1-9; 0066, lines 3-8, 18-21; 0067]) }, and

wherein when said video information is distributed from the video contents server to the mobile phone while a user is using the mobile phone, the mobile phone saves (e.g., download, store, or record) the distributed video information { (see pg. 6, [0060, lines 1-19; 0061, lines 1-10]; pg. 11, [0111, lines 13-16]) }, and

further wherein when the video information is distributed from the video contents server to the mobile phone while the user is not using the mobile phone { (see pg. 26, [0254, lines 7-8]; pg. 37, [0361, lines 1-5]) },

the mobile phone displays the saved video information in response to a user's instruction { (see pg. 3, [0033, lines 16-18; 0034]; pg. 42, [0404, lines 1-3; 0406, lines 1-2]; pg. 45, [0447]), where the system includes an audio/video player. }. Barnes does not specifically disclose having the feature(s) the mobile phone displays the distributed video information for only a time period, and thereafter the mobile phone stops displaying the video information while the user is still not using the mobile phone and saves the remaining video information distributed after the time period has elapsed. However, the examiner maintains that the feature(s) the mobile phone displays the distributed video information for only a time period, and thereafter the mobile phone stops displaying the video information while the user is still not using the mobile phone and saves the remaining video information distributed after the time period has elapsed was well known in the art, as taught by Shiotsu.

In the same field of endeavor, Shiotsu discloses the feature(s) the mobile phone displays the distributed video information for only a time period { (see col. 4, lines 12-18, 33-37; col. 5, lines 13-14; col. 7, lines 8-13; col. 8, lines 19-39), where the TV signal is displayed for a duration }, and

thereafter the mobile phone stops displaying the video information while the user is still not using the mobile phone and saves the remaining video information distributed after the time period has elapsed { (see col. 4, lines 12-18,33-37; col. 7, lines 8-13; col. 8, lines 19-39; col. 9, lines 17-26; Figs. 1-2), where the system displays the TV broadcast for a timed duration then switches to recording }.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Barnes and Shiotsu to have the feature(s) the mobile phone displays the distributed video information for only a time period, and thereafter the mobile phone stops displaying the video information while the user is still not using the mobile phone and saves the remaining video information distributed after the time period has elapsed, in order to enable setting an optimal operating state, as taught by Shiotsu (see col. 1, lines 62-67).

Regarding **claims 2-3**, Barnes discloses a method for distributing video information to a mobile phone from a video contents server, based on push technology, said video contents server configured to store therein the video information to be distributed, under control of a user management server which controls user registration and video information distribution { (see pg 4, [0041, lines 8-14]; pg. 6, [0061]; pg. 7, [0069, lines 1-7]; pg. 21, [0211]; Figs. 1-3), where a MNCS is operated by a service provider }, comprising:

registering a user request for a video information distribution service about an area to the user management server in advance { (see pg. 38, [0368, lines 1-9]; pg. 37, [0361, lines 1-5]; pgs. 38-39, [0370]; pg. 45, [0434]), where the system provides information (see pg. 42, [0400, lines 1-3; 0401, lines 1-3) };

detecting traffic of a radio channel connected to the mobile phone { (see pg. 6, [0060, lines 1-9; 0066, lines 3-8,18-21; 0067]), where the system determines a link condition for communication (see pg. 7, [0068]) as evidenced by the fact that one of ordinary skill in the art would clearly recognize };

when the detected traffic is lower than a threshold { (see pg. 6, [0060, lines 1-9; 0066, lines 3-8,18-21; 0067]) },

distributing video information from the video contents server to the mobile phone based on said push technology { (see pg. 4, 0040, lines 1-6); pg. 6, [0061]; pg. 11, [0111, lines 13-16]; pg. 45, [0434]) };

when said video information is distributed from the video contents server to the mobile phone while a user is using the mobile phone, causing the mobile phone to save the distributed video information { (see pg. 6, [0060, lines 1-19; 0061, lines 1-10]; pg. 11, [0111, lines 13-16]) };

when the video information is distributed from the video contents server to the mobile phone while the user is not using the mobile phone { (see pg. 26, [0254, lines 7-8]; pg. 37, [0361, lines 1-5]) }, and

causing the mobile phone to display the saved video information on the basis of a user's instruction { (see pg. 3, [0033, lines 16-18; 0034]; pg. 42, [0404, lines 1-3; 0406, lines 1-2]; pg. 45, [0447]), where the system includes an audio/video player. }. Barnes does not specifically disclose having the feature(s) causing the mobile phone to display the distributed video information for only a time period, and thereafter causing the mobile phone to stop displaying the video information while the user is still not using the mobile phone and save



the remaining video information distributed after the time period has elapsed. However, the examiner maintains that the feature(s) causing the mobile phone to display the distributed video information for only a time period, and thereafter causing the mobile phone to stop displaying the video information while the user is still not using the mobile phone and save the remaining video information distributed after the time period has elapsed was well known in the art, as taught by Shiotsu.

In the same field of endeavor, Shiotsu discloses the feature(s) causing the mobile phone to display the distributed video information for only a time period { (see col. 4, lines 12-18,33-37; col. 5, lines 13-14; col. 7, lines 8-13; col. 8, lines 19-39), where the TV signal is displayed for a duration }, and

thereafter causing the mobile phone to stop displaying the video information while the user is still not using the mobile phone and save the remaining video information distributed after the time period has elapsed { (see col. 4, lines 12-18,33-37; col. 7, lines 8-13; col. 8, lines 19-39; col. 9, lines 17-26; Figs. 1-2), where the system displays the TV broadcast for a timed duration then switches to recording }.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Barnes and Shiotsu to have the feature(s) causing the mobile phone to display the distributed video information for only a time period, and thereafter causing the mobile phone to stop displaying the video information while the user is still not using the mobile phone and save the remaining video information distributed after the time period has elapsed, in order to enable setting an optimal operating state, as taught by Shiotsu (see col. 1, lines 62-67).

### **Response to Arguments**

6. Applicant's arguments filed 24 January 2011 have been fully considered but they are not persuasive.

The Examiner respectfully disagrees with applicant's arguments as the applied reference(s) provide more than adequate support and to further clarify (see the above claims for relevant citations and comments in this section).

7. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding applicant's argument of claim 1 on pg. 11, 1<sup>st</sup> full par., "...does not describe that the decision on whether to display or store the video information has been sent before..."; and on pg. 11, 2<sup>nd</sup> full par., "...says nothing about making a decision on whether or not to store received video information even while the users is not using the mobile phone...", the Examiner respectfully disagrees. Applicant has failed to interpret and appreciate the combined teachings of well-known prior art Barnes and Shiotsu that clearly discloses the claimed feature(s) as would be clearly recognized by one of ordinary skill in the art. As a note, applicant admits "...Barnes...phone...can receive video information...storing the received video for future reproduction..." (see pg. 11, 1<sup>st</sup> full par., lines 1-2). In particular, Barnes discloses the language as related to the claimed feature(s)

if the mobile phone is not in use and the video information has not already been provided { (see pg. 26, [0254, lines 7-8]; pg. 37, [0361, lines 1-5]), where the device is not involved in other activities and upon entering an area provided a movie, in other words, a new movie },

the video information is displayed in real time, wherein said video information about the area is distributed from the video contents server to said mobile phone via said push technology { (see pg. 38, [0368, lines 1-9]; pg. 45, [0434-0435]; pg. 6, [0061]), where the device can receive and store transmission of content such as a presentation and live audio/visual (see pg. 6, [00063]) }. As further support in the same field of endeavor, Shiotsu discloses the language as related to the claimed feature(s)

the mobile phone displays the distributed video information for only a time period { (see col. 4, lines 12-18,33-37; col. 5, lines 13-14; col. 7, lines 8-13; col. 8, lines 19-39), where the TV signal is displayed for a duration }. Therefore, the combination(s) of the reference(s) Barnes and Shiotsu as addressed above more than adequately meets the claim limitations.

8. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "...information **only if** the traffic..." - see pg. 12, 2<sup>nd</sup> par.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding applicant's argument on pg. 12, 2<sup>nd</sup> par. (see above), the applicant's argument relies on a feature(s) not recited in the claim(s).

Furthermore, if applicant considers the language to be supported see the following:

Regarding applicant's argument on pg. 12, 2<sup>nd</sup> par., "...does not teach sending the video information only if the traffic is below a certain level...", the Examiner respectfully disagrees. Applicant has failed to interpret and appreciate the combined teachings of well-known prior art Barnes and Shiotsu that clearly discloses the claimed feature(s) as would be clearly recognized by one of ordinary skill in the art. In particular, Barnes discloses the language as related to the claimed feature(s)

when the detected traffic is lower than a threshold { (see pg. 6, [0060, lines 1-9; 0066, lines 3-8,18-21; 0067]), where the system determines a link condition for communication (see pg. 7, [0068]) as evidenced by the fact that one of ordinary skill in the art would clearly recognize that available resource for transmission must be acceptable to transmit data },

distributing video information from the video contents server to the mobile phone based on said push technology { (see pg. 4, 0040, lines 1-6); pg. 6, [0061]; pg. 11, [0111, lines 13-16]; pg. 45, [0434]) }. Therefore, the reference Barnes as well as the combination(s) of prior art Shiotsu more than adequately meets the claim limitations.

### **Conclusion**

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
  - a. Sekiguchi et al. (US 7,200,633 B2) discloses an information delivery system and information delivery method.
  - b. Wang et al. (2004/0143841 A1) discloses a voice and video greeting system for personally advertisement and method.

- c. Abecassis (US 6,553,178 B2) discloses an advertisement subsidized video-on-demand system.
10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **WILLIE J. DANIEL JR** whose telephone number is (571)272-7907. The examiner can normally be reached on 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Appiah can be reached on (571) 272-7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/WJD,Jr/

WJD,Jr  
16 March 2011

/Charles N. Appiah/  
Supervisory Patent Examiner, Art Unit 2617